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10/072,528	02/08/2002	Eric Polesuk	P/77-2	2909

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/072,528
Filing Date: February 08, 2002
Appellant(s): POLESUK, ERIC

Philip M. Weiss
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/09/09 and 4/1/09 appealing from the Office action mailed 7/08/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2087181	Conway	7-1937
4,185,753	Leto	1-1980

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conway (United Sates Patent No. 2,087,181).

Conway discloses a method of putting hair foil in a person's hair comprising removing a first sheet of hair foil from a pop-up dispenser, the sheet having a lead portion and a trailing portion with the lead portion extending through the dispensing orifice and the trailing portion overlapping the lead portion of the next hair foil sheet; and pulling the next hair foil sheet through the orifice of the dispensing orifice by withdrawing the first sheet; and applying the first sheet to a person's hair (see col. 1, line 36 through col. 2, line 14). Conway discloses the claimed invention except for the foil sheets having a width of 3.5 to 6 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the foil sheets 3.5 to 6 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leto (United Sates Patent No. 4,185,753).

Leto discloses a method of putting hair foil in a person's hair comprising removing a first sheet of hair foil from a pop-up dispenser, the sheet having a lead portion and a trailing portion with the lead portion extending through the dispensing orifice and the trailing portion overlapping the lead portion of the next hair foil sheet; and pulling the next hair foil sheet through the orifice of the dispensing orifice by withdrawing the first sheet; and applying the first sheet to a person's hair (see col. 4, lines 21-45 and figure 3). Leto discloses the claimed invention except for the foil sheets having a width of 3.5 to 6 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the foil sheets 3.5 to 6 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

(10) Response to Argument

With regard to the arguments about the 35 U.S.C 103 (a) over Conway on pages 8-10 of the brief filed 2/21/08, Appellant has not clearly pointed out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the reference cited; however, Appellant has raised the commercial success issues in the declaration filed 5/30/2006. Appellant is noted that as addressed such issues in the response mailed 6/29/06, the declaration is insufficient to overcome the rejection of claim based upon commercial success because: (1) Commercial success has not been established and (2) A nexus between the claimed invention and the alleged success

has not been established. The declaration only gives Product Club's pop-up foil market share for its own market while ignoring the existence of any competitors. Therefore, the declaration does not show this product's place in the market. What is the market share with respect to other companies selling foil sheets? Also, in paragraph 9 of the declaration, Appellant made a statement that alleged success of the pop-up foil product must be due to the method, since the method is what sets it apart from the prior art. There is no support for the assumption that the alleged success is due to the method, since other factors, such as advertising, could be the cause of the alleged success. Also, a nexus between the claimed invention and the alleged success has not been established.

Appellant has also argued on pages 10-11 of the brief that the hair foil of the claims being significantly longer than the end wrap paper of Leto, however, Appellant has not claimed the length of the foil, further Appellant has argued that foil is significantly heavier that the paper of Leto. Appellant is noted that such features are not recited in the claims, therefore, the argument is irrelevant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/R.D./

Conferees:

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775

/Cris L. Rodriguez/
Supervisory Patent Examiner, Art Unit 3732